

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: **Jim Dougherty**  
Serial No.: **10/080,778**  
Filing Date: **22 February 2002**  
Title: **Structured Design Documentation Importer**  
Examiner: **Adam L. Basehoar**  
Art Unit: **2178**  
Atty Docket: **AINNO.0110**

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Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO OFFICE ACTION**

Sir:

No fees are believed to be required. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to Deposit Account No. 50-0392. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to Deposit Account No. 50-0392.

In response to the Office Action mailed March 20, 2006, Applicant offers the following amendments and remarks:

**Amendments to the claims** begin on page 2 of this paper

**Remarks/Arguments** begin on page 10 of this paper.

**In the Claims:**

The following is a complete listing of the claims currently pending in the present application:

1. (Cancelled)

2. (Cancelled).

3. (Cancelled)

4. (Cancelled)

5. (Cancelled)

6. (Cancelled)

7. (Cancelled)

8. (Cancelled)

9. (Cancelled)

10. (Cancelled)

11. (Cancelled)

12. (Cancelled)

13. (Cancelled)

14. (Cancelled)

15. (Cancelled)

16. (Cancelled)

17. (Cancelled)

18. (Cancelled)

19. (Cancelled)

20. (Cancelled)

21. (Cancelled)

22. (Cancelled).

23. (Cancelled)

24. (Cancelled)

25. (Cancelled)

26. (Cancelled)

27. (Cancelled)

28. (Cancelled)

29. (Cancelled)

30. (Cancelled)

31. (Cancelled)

32. (Cancelled)

33. (Cancelled)

34. (Cancelled)

35. (Cancelled)

36. (Cancelled)

37. (Cancelled)

38. (Cancelled)

39. (Cancelled)

40. (Cancelled)

41. (Cancelled)

42. (Cancelled).

43. (Cancelled)

44. (Cancelled)

45. (Cancelled)

46. (Cancelled)

47. (Cancelled)

48. (Cancelled)

49. (Cancelled)

50. (Cancelled)

51. (Cancelled)

52. (Cancelled)

53. (Cancelled)

54. (Cancelled)

55. (Cancelled)

56. (Cancelled)

57. (Cancelled)

58. (Cancelled)

59. (Cancelled)

60. (Cancelled)

61. (Original) A method for importing specifications from a product design document for use in manufacturing testing software, the method comprising the computer implemented steps of:

(a) extracting test specification data from an electronic design document, wherein the design document is in a structured format containing both data and metadata;

(b) translating the extracted test specification data into a format that is readable by the testing software; and

(c) importing the translated test specification data into test executive software that manages testing and passes test specifications into applicable sections of underlying test library software that performs specific test functions.

62. (Currently amended) The method according to claim 61, wherein the test specifications ~~may include~~ at least one of the following:

product platform;

product code;

revision number;

product characteristics;

list of tests including test sequence;

test name;

test method;

test description;

test conditions;

test limits; and

resolution of digits.

63. (Original) The method according to claim 61, wherein step (a) further comprises assembling a variable list containing test parameter values from said test specifications.

64. (Original) The method according to claim 61, wherein the translated test specification data is stored in a database used by the testing software.

65. (Original) The method according to claim 61, wherein the translated test specification data is stored in memory for immediate use by the testing software.
66. (Original) The method according to claim 61, wherein the test specifications imported into the test executive include test specification types that are pre-defined by the test executive software.
67. (Original) The method according to claim 61, wherein the test specifications imported into the test executive include user-defined test specification types.
68. (Original) The method according to claim 61, further comprising:
- (d) debugging and editing the test specifications with the test executive software in the event said design document contains mistakes; and
  - (e) exporting the edited test specifications into a second, revised design document.
69. (Original) A computer program product, in a computer readable medium, for importing specifications from a product design document for use in manufacturing testing software, the computer program product comprising:
- (a) first instructions for extracting test specification data from an electronic design document, wherein the design document is in a structured format containing both data and metadata;
  - (b) second instructions for translating the extracted test specification data into a format that is readable by the testing software; and
  - (c) third instructions for importing the translated test specification data into test executive software that manages testing and passes test specifications into applicable sections of underlying test library software that performs specific test functions.

70. (Currently amended) The computer program product according to claim 69, wherein the test specifications ~~may~~ include at least one of the following:

- product platform;
- product code;
- revision number;
- product characteristics;
- list of tests including test sequence;
- test name;
- test method;
- test description;
- test conditions;
- test limits; and
- resolution of digits.

71. (Original) The computer program product according to claim 69, wherein the first instructions (a) further comprise instructions for assembling a variable list containing test parameter values from said test specifications.

72. (Original) The computer program product according to claim 69, wherein the translated test specification data is stored in a database used by the testing software.

73. (Original) The computer program product according to claim 69, wherein the translated test specification data is stored in memory for immediate use by the testing software.

74. (Original) The computer program product according to claim 69, wherein the test specifications imported into the test executive include test specification types that are pre-defined by the test executive software.

75. (Original) The computer program product according to claim 69, wherein the test specifications imported into the test executive include user-defined test specification types.

76. (Original) The computer program product according to claim 69, further comprising:

(d) fourth instructions for debugging and editing the test specifications with the test executive software in the event said design document contains mistakes; and

(e) fifth instructions for exporting the edited test specifications to a second revised design document.

77. (Original) An apparatus for importing specifications from a product design document for use in manufacturing testing software, the apparatus comprising:

(a) a data extraction mechanism for extracting test specification data from an electronic design document, wherein the design document is in a structured format containing both data and metadata;

(b) a translator for translating the extracted test specification data into a format that is readable by the testing software; and

(c) an import mechanism for importing the translated test specification data into test executive software that manages testing and passes test specifications into applicable sections of underlying test library software that performs specific test functions.

78. (Original) The apparatus according to claim 77, wherein the translated test specification data is stored in a database used by the testing software.

79. (Original) The apparatus according to claim 77, wherein the translated test specification data is stored in memory for immediate use by the testing software.

**REMARKS**

Claims 61-79 are pending in the present application. Claims 62 and 70 have been amended.

Reconsideration of the claims is respectfully requested.

**I.     35 U.S.C. §112, second paragraph**

Claims 62 and 70 have been amended in accordance with the Examiner's suggestion to make the language more definite.

**II.    35 U.S.C. §102, anticipation**

The Examiner has rejected claims 61-67, 69-75 and 77-79 under 35 USC §102(e) as being anticipated by Schaefer (US 2003/0084429). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994).

Claim 61 recites:

61. A method for importing specifications from a product design document for use in manufacturing testing software, the method comprising the computer implemented steps of:

(a) extracting test specification data from an electronic design document, wherein the design document is in a structured format containing both data and metadata;

(b) translating the extracted test specification data into a format that is readable by the testing software; and

(c) importing the translated test specification data into test executive software that manages testing and passes test specifications into applicable sections of underlying test library software that performs specific test functions.

Claims 69 and 77 contain similar limitations for purposes of the present discussion.

The Schaefer reference cited by the Examiner appears to have some superficial similarities with the present invention as much as it is directed toward product testing software. However, a closer reading of Schaefer reveals that it does not in fact teach all of the limitations of the claimed invention.

First, the claimed invention is directed toward product testing within a manufacturing environment. In contrast, Schaefer is directed toward software development, not manufacturing. The process of writing software does not constitute manufacturing according to any common or reasonable use of that term.

Furthermore, the process taught in Schaefer does involve an electronic product design document from which test specifications are drawn. Schaefer uses GUI maps, which are files that contain information about user interface objects. These GUI maps are then translated into database tables. The GUI maps relate to the organization of the software and are used to locate software objects. The GUI maps do not contain any normative data regarding product testing specifications and are not equivalent to the design document of the claimed invention.

A separate data input component is used by Schaefer to create test cases to be entered into the tables created from the GUI maps. The tables allow the test cases to be matched with the correct execution paths. Schaefer does teach importing data from a structured document like a spread sheet (paragraph [0053]). However, this imported data is merely example input data used to run specific execution paths and does not constitute normative testing specifications taken from a product design document.

Because claims 62-67, 68-75, and 78-79 depend from claims 61, 69, and 77 respectively, they are distinguished from Schaefer for the reasons explained above. Furthermore, the dependent claims include limitations not taught or suggested by Schaefer. For example, claims 62, 63, 66 and 67 recite:

62. The method according to claim 61, wherein the test specifications include at least one of the following:

- product platform;
- product code;
- revision number;
- product characteristics;
- list of tests including test sequence;
- test name;
- test method;

test description;  
test conditions;  
test limits; and  
resolution of digits.

63. The method according to claim 61, wherein step (a) further comprises assembling a variable list containing test parameter values from said test specifications.

66. The method according to claim 61, wherein the test specifications imported into the test executive include test specification types that are pre-defined by the test executive software.

67. The method according to claim 61, wherein the test specifications imported into the test executive include user-defined test specification types.

These claims relate to normative testing data for product specifications which is not taught by Schaefer, as explained above.

Therefore, Applicant respectfully asserts that the rejection of claims 61-67, 69-75 and 77-79 under 35 U.S.C. § 102 has been overcome.

### III. 35 U.S.C. §103, obviousness

The Examiner has rejected claims 68 and 76 under 35 USC §102(e) as being anticipated by Schaefer (US 2003/0084429). This rejection is respectfully traversed.

A prima facie case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). In a proper obviousness determination, regardless of whether the changes from the prior art are "minor," the changes must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the claimed invention. *In re Chu*, 66 F.3d 292, 298, 36 U.S.P.Q.2d 1089, 1094 (Fed. Cir. 1995).

Because claims 68 and 76 depend from claims 61 and 69, respectively, they are distinguished from Schaefer for the reasons stated above. Furthermore, there is no teaching in Schaefer that suggests the limitations of claims 68 and 76, which recite:

68. The method according to claim 61, further comprising:
  - (d) debugging and editing the test specifications with the test executive software in the event said design document contains mistakes; and
  - (e) exporting the edited test specifications into a second, revised design document.

76. The computer program product according to claim 69, further comprising:

- (d) fourth instructions for debugging and editing the test specifications with the test executive software in the event said design document contains mistakes; and
  - (e) fifth instructions for exporting the edited test specifications to a second revised design document.

As explained above, Schaefer does not teach or suggest using a product design document and associated normative specifications.

Therefore, Applicant respectfully asserts that the rejection of claims 68 and 76 under 35 U.S.C. § 103 has been overcome.

**Conclusion**

It is respectfully urged that the subject application is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: June 20, 2006

Respectfully submitted,



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